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09/829,614

04/10/2001

Luis Eduardo Gutierrez-Sheris

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1133 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

BARTLEY, KENNETH

ART UNIT

PAPER NUMBER

3693

MAIL DATE

DELIVERY MODE

10/01/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/829,614

Applicant(s)GUTIERREZ-SHERIS, LUIS
EDUARDO**Examiner**

KENNETH L. BARTLEY

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>08/20/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 29, 2008 has been entered.

Response to Amendment

2. Applicant has not amended their claims.
3. The Examiner thanks Applicant for amending the ADS, and removes this objection.

Response to Arguments

4. Applicant's arguments filed July 28, 2008 have been fully considered but they are not persuasive. The Examiner provides a response below in **bold**.

To overcome the prior art, the Applicant has provided a declaration under 37 CFR § 1.131. However, the Examiner respectfully requests further information regarding the time period from when the invention is conceived to when the invention is reduced to practice. Specifically, the Examiner is looking for facts that establish when work began on the invention, the time period of work on the invention, and when work was finished (reduced to practice). Periods of inactivity should also be accounted for. The Examiner notes that the Applicant

provides Exhibits A-I, but some of these Exhibits are references to other documents and while providing a time line for work on the application, they do not present direct evidence of what the work was. For example, Exhibit B refers to work done on 13/3, which is a "draft" application, but there is no assertion or evidence that this application includes relevant parts of the CIP at the point in time provided. The other Exhibits by themselves do not establish facts and in some cases it is not clear what they are trying to establish (e.g. Exhibit C, as just one example). Exhibit A indicates the time the invention was conceived, but further evidence is needed to determine when the invention was reduced to practice (due diligence period). The Examiner provides more detail below.

Applicant reviews prior art rejection basis, pg 2 of remarks:

Claims 1-10, 12-17, 20 and 24-28 were rejected under 35 U.S.C.103(a) as being unpatentable over U.S. Patent 7,120,608 to Gallagher, et al. ("Gallagher"), in view of U.S. Patent 6,039,250 to Ito et al. ("Ito"). Claims 11, 18, 19, 21-23, 29 and 30 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gallagher in view of Ito and in further view of U.S. Pub. No. US2002/0029193 to Ranjan and Shah ("Ranjan").

Applicant reviews/argues filing date:

It is submitted that neither Gallagher nor Ranjan is valid prior art with respect to the present application. The present application has a filing date of April 10, 2001. Gallagher, which issued on October 10, 2000, is not prior art under 102 (b) and therefore can only be prior art under either 102(a) or 102(e) based on its issue date (under 102(a)) or based on its filing date of October 30, 2000, or its priority filing date of August 15, 2000. In the Office Action, the Examiner deems Gallagher to have the relevant filing date of October 30, 2000 (not its priority filing date). But since the earliest relevant date of Gallagher is August 15, 2000, the applicant shall consider August 15, 2000 as the relevant date for Gallagher.

The Examiner notes that Gallagher (US Patent 7,120,608 dated 10/30/2000) was a CIP of application No. 09/639,014 (dated 08/15/2000). Since Gallagher is a CIP, new information was added to the application which may be relevant to the instant application. Since the dates do not straddle the instant application dates, it did not matter which date was used, and therefore the Examiner used the later date and avoided having to review two applications. Nevertheless, the Examiner accepts Applicant's use of August 15, 2000.

The Applicant also cites Ranjan dates, bottom of page 2:

Ranjan, which issued on March 7, 2002 from an application filed on August 31, 2001, can only be prior art under 102(e) based on its priority filing date of September 1, 2000.

The date is noted.

Applicant files CFR 1.131 to swear behind dates:

As discussed in detailed below, applicant has submitted, concurrently herewith, a Declaration under C.F.R. 1.131 that establishes an invention date which predates the priority dates of Gallagher and Ranjan and, therefore, neither of these references is valid prior art with respect to the present application.

Applicant reviews support for data-input in provisional application, pg. 3 of remarks:

In the Office Action under reply, the Examiner indicated that the provisional application does not provide support for the internet related limitations recited in independent claims 1, 14 and 25, thus precluding providing these claims the earlier priority date of the provisional application. Specifically, the Examiner indicated that there is no support in the provisional application for "transmitting a data-input document" and "entering transaction data into said data-input document" as recited in claim 1, for "customer accessing said money-transfer service via internet and an Internet-access device," "transmitting a data-input document" and "opening said data-input document" as recited in claim 14 and "money-transfer service including document means, for transmitting transaction documents," "each customer communication system comprising an access means, for receiving said transaction documents" and "inputting transaction data into said transaction documents" as recited in claim 25.

In response, Applicant has included with this submission a Declaration under 37 C.F.R. 1.131 ("Declaration") that establishes Applicant's conception prior to August 15, 2000 of methods for accepting online money transfer techniques including the above-quoted steps and features, and that also demonstrates diligence from just prior to August 15, 2000 to the filing of the present application on April 10, 2001. Therefore, the claimed invention is entitled to a date of invention, at least for independent claims 1, 14 and 25, that predates the priority dates of Gallagher and Ranjan.

Moreover, those remaining limitations in independent claims 1, 14 and 25 and those recited in claims dependent thereon which the Examiner did not object to are supported in the provisional application. Therefore, all the claims in the application are entitled to a date of invention that predates the (priority) filing dates of both Gallagher and Ranjan.

In view of the foregoing, neither Gallagher nor Ranjan is valid prior art with respect to the present application. It is therefore requested that the rejection of claims 1, 14 and 25 and all claims dependent thereon be withdrawn.

With all due respect, the Examiner requires more information.

The Examiner cites the following from § 1.131(b):

The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

Therefore, the Applicant can show:

1. Actual reduction to practice. (This was not demonstrated)
2. If actual reduction to practice is not established, the Applicant needs to establish that conception date is before the effective date of the reference.

Let's assume this has been established, and is June 4, 1999 as argued by the Applicant. Then, since the reference dates are August 15, 2000 (Gallagher et al.) and September 1, 2000 (Ranjan et al.) are after the conception date, this has been established.

3. Further, if the actual reduction to practice is not established, Applicant must demonstrate due diligence from before the reference dates to either the subsequent reduction to practice date or the filing date. (This has not been established)

The Applicant specifically needs to provide information on when work was commenced and finished on developing the claimed invention. Further, the Applicant must account for the entire period for which due diligence is shown. The actual dates and/or time periods of acts relied on to establish diligence should be provided.

The Examiner emphasizes from § 1.131(b):

The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form

part of the affidavit or declaration or their absence must be satisfactorily explained.

Specifically, the Examiner does not find dates provided (or asserted) as to when the actual reduction of the invention occurred. This includes documentation indicating when work started, the progress of the work, and when the work was completed (actual reduction to practice). See MPEP §§ 2138-2138.06

The Examiner is looking for a timeline and evidence of when the actual work started and when work was completed (actual reduction period). The Applicant must account for the entire due diligence period. Further, periods of inactivity should be explained.

The Applicant provided Exhibit's B-I, but with all due respect, there is no documentation provided as to what Application is being worked on, other than a reference number (13/3 in Exhibit B for example).

Therefore, the Examiner maintains the prior art rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-10, 12-17, 20, and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,120,608 to Gallagher, et al., in view of U.S. Patent No. 6,039,250 to Ito and Hiroya.

Regarding applicant claim 1, 3, 8, 14, 20, 24 and 25,

- a. A method of transferring a sum of money from a customer to a beneficiary via a money-transfer service and an electronic communications network...

Gallagher, et al., discloses:

“Systems and Methods for Implementing Person-to-Person Money Exchange” (Title) and “...systems and methods for effecting online financial transactions between individuals or between individuals and entities such as banks, merchants and other companies.” (col. 1, lines 52-55);

- b. said customer accessing said money-transfer service via said electronic communications network...

“...user accesses a fund exchange server to establish an online account, which is used to transfer funds...” (col. 1, lines 57-60). Access can be via desktop computer, which can be an internet access device (col. 4, lines 46-52).

- c. transmitting a data-input document from said money-transfer service to said customer via said electronic communications network...

The fund exchange server (money-transfer service) provides the user (customer) one or more web pages for establishing accounts and initiating transactions (col. 5, lines 45-50).

- d. said customer entering transaction data into said data-input document to record the amount of said sum of money to be transferred, an identification of said customer, an identification of said beneficiary, and basic payment data for said money-transfer service to use in collecting said sum of money...

The payor (customer) "...is prompted to enter an amount of funds for transfer and identification information for the recipient..." (where the recipient is the beneficiary) (col. 7, lines 33-40). Information can also include the sender's (identify the customer) name (col. 7, lines 60-65). Basic payment data, such as credit card information, is also provided when the account is established (col. 5, lines 64-67 and col. 6, lines 1-3).

- e. said money-transfer service collecting said sum of money in accordance with said basic payment data...

Funds are transferred to an online account from a funding account based on basic payment data (col. 5, lines 64-67 and col. 6, lines 1-3).

- f. providing said customer with a unique fund-pick-up code...

User (customer) can create an "identity confirmation query," which could be a unique code that the beneficiary must respond to (col. 7, lines 36-40).

- g. and informing said beneficiary of said unique fund-pick-up code...

The beneficiary needs to respond correctly to receive the funds, therefore, the beneficiary would have to be notified in some manner of the code.

Gallagher, et al., discloses additional system information including:

- i. a fund exchange system that includes an electronic communication network (col. 4, lines 32-36).
- ii. fund exchange server connected to the communication network (Fig. 1).
- iii. pages and forms provided by a fund exchange server for transmitting (from customer) and receiving (to beneficiary) transaction documents (Figs. 3 and 5).
- iv. a database for storing information and data (col. 5, lines 64-66).
- v. client (customer and beneficiary) devices connected to a communication network (col. 4, lines 32-36); access provided by computers and cell phones (col. 4, lines 48-52).

Although Gallagher, et al., provides for a confirmation query that can be used by a customer to transmit a unique pick-up code, he **does not disclose the fund exchange server providing a pick-up code.**

Ito and Hiroya, in the same field of endeavor, teach payment processes wherein they provide for a random number sequence as a security key (fund exchange

server providing a pick-up code) (col. 4, lines 54-56). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to have the fund exchange server of Gallagher, et al., provide an automated fund-pick-up code as disclosed by Ito and Hiroya, motivated by the fact that Ito and Hiroya provide for an “electronic money server” that includes a random number sequence as a security key and the fund exchange server could generate a random number and provide it to the customer as a pick-up code, thus eliminating the need for the customer to create the code (and saving time).

Regarding claims 2 and 26: The method of claim 1 wherein said electronic communications network includes the Internet, and the step of accessing said money-transfer service includes transmitting an access request from said customer to said money-transfer service via said Internet.

Gallagher provides that a fund exchange server is connected to a communication network that can include the internet (col. 4, lines 36-39).

Regarding claims 4 and 15: The method of claim 3 further including said customer having an IP (Internet Protocol) address and said money-transfer service recording said IP address in response to said customer accessing said money-transfer service.

Gallagher, et al., provides communication using the Internet by the payor (customer) with the fund exchange server which would require the fund

server recording in some manner the payor's IP address (Microsoft Computer Dictionary, Microsoft Press, 5th Ed., 2002 pg. 287).

Regarding applicant claims 5 and 16: The method of claim 4 further including said money-transfer service creating a transaction record including said IP address, said transaction data and said unique fund-pick-up code.

Gallagher, et al., discloses that the user provides an e-mail address, mailing address, and/or "other information" as may be necessary, including transaction data, such as "amount to sent" (col. 5, lines 58-61 and Fig. 3). While an IP address is not specifically mentioned, it could be part of "other information" used to identify the customer.

Regarding claims 6 and 17: The method of claim 5 further including said money-transfer service transmitting a transaction confirmation request to said customer via said Internet.

Gallagher, et al., provides that payor (customer) "...is notified, preferably by an electronic message, that the payee has responded to the identity confirmation query." (col. 8, lines 23-26).

Regarding claim 7: The method of claim 6 wherein said electronic communications network includes the PSTN (Public Switched Telephone Network), and further including

said customer contacting said money-transfer service via said PSTN to obtain said unique fund-pick-up code.

Gallagher et al., discloses user (customer) can use a cell phone (col. 4, lines 48-52) as well as a computer. It is well known in the art that cell phones and computers can use the PSTN.

Regarding claims 9, 10, 12, and 13:

(9) The method of claim 8 wherein the step of said customer contacting said money-transfer service via said PSTN includes said customer informing said money-transfer service of additional payment data.

(10) The method of claim 9 wherein said basic payment data includes an identification of a customer account at a payment institution, and the step of informing said money-transfer service of additional payment data includes revealing a unique payment code associated with said customer account.

(12) The method of claim 8 wherein the step of said customer entering data includes entering additional payment data.

(13) The method of claim 12 wherein said basic payment data includes an identification of a customer account at a payment institution, and the step of entering additional payment data includes entering a unique payment code associated with said customer.

Gallagher et al., allows that user can request additional money transferred to online account, by providing information such as account number, password, PIN number, etc. (col. 6, lines 26-32).

Regarding claim 27: The system of claim 26 wherein said Internet-access apparatus includes a web browser and a display, said money-transfer service includes a web-based server, and said document means includes means for transmitting said transaction documents as HTML (Hypertext Markup Language) documents capable of being rendered on said display via said web browser.

Gallagher et al., disclose that client devices include browsing programs (col. 4, lines 52-58) used on a monitor with a GUI interface (col. 4, lines 58-65). Also, "...content is typically presented to the user as a web page formatted according to downloaded JavaScript code and HTML code..." (col. 5, lines 31-34).

Regarding claim 28: The system of claim 27 wherein said electronic communications network includes the PSTN (Public Switched Telephone Network) and each of said customer communication systems includes a DTMF (Dual-Tone, Multiple Frequency) access device connected to said PSTN...

Cell phones can contain DTMF (defined by phonescoop.com/glossary).

7. Claims 11, 18, 19, 21-234, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as combined in section (6) above, in further view of Pub. No. US 2002/0029193 to Ranjan and Shah.

Regarding claims 11,18,19, 21-23, 29, and 30:

Although Gallagher, et al., discloses a cell phone, he does not disclose verbal communication or a method where the phone number is automatically provided (AIN).

Ranjan and Shah, in the same field of endeavor, teach a payment process using telephones that include a caller ID (AIN to match with customer phone number) and voice capability (para. 39 and 45). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include an AIN and voice capability as disclosed by Gallagher and Ito, et al., as combined above, motivated by Ranjan and Shah who use such a caller ID and voice capability to enhance security and that these features will augment the security disclosed in the combined reference in section 11, where enhanced security is important given that money transfer is involved.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KENNETH L. BARTLEY whose telephone number is

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(571)272-5230. The examiner can normally be reached on Monday through Friday,
8:00 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jagdish Patel can be reached on (571) 272-6748. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAGDISH N PATEL/

Primary Examiner, Art Unit 3693